

Claims 16-24 were rejected under 35 USC 103(a) as being allegedly unpatentable over the combined teachings of Weber and WO 97/46531. Reconsideration is requested in view of the instant amendment.

The statement of rejection (Office Action, page 2, last complete paragraph) acknowledges that the invention defined in claim 16 provides an unexpected, synergistic (greater-than-additive) effect ("that 'one skilled in this art could not have expected that isoflavonoids would potentiate cytotoxicity of the conventional cytotoxic agents' . . . is true").

By acknowledging the synergistic effect of the invention as defined in the rejected claims, the statement of rejection effectively acknowledged patentability, i.e., a synergistic effect is sufficient to demonstrate non-obviousness of the claimed subject matter under § 103. *In re Corkill*, 226 USPQ 1005 (Fed. Cir. 1995). Although patentability of the claimed subject matter is acknowledged, the §103(a) rejection is maintained, apparently, because "the instant claims fail . . . to recite a 'potentiate cytotoxicity' effect" (Office Action, page 2, last complete paragraph).

As explained above, the claims as amended hereby expressly recite (*emphasis added*)

administration, during the treatment with a cytotoxic agent, of a
cytotoxic potentiating amount of an isoflavonoid.

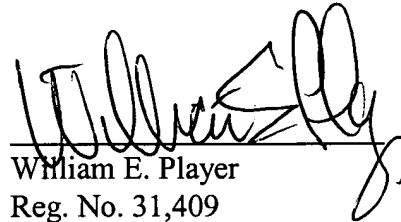
Since the claims as presently amended expressly recite that a "cytotoxic potentiating" effect is obtained in accordance with the invention, the §103(a) rejection of record is overcome and, therefore, withdrawal of the rejection is in order.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By:



William E. Player
Reg. No. 31,409

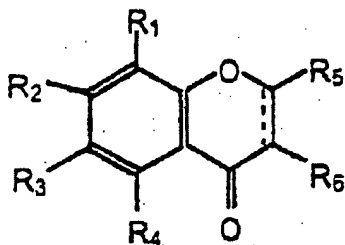
400 Seventh Street, N.W.
The Jenifer Building
Washington, D.C. 20004
Tel. (202) 638-6666
Fax (202) 393-5350
Date: June 6, 2003
WEP/kpc
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Marked up version of amendments

IN THE CLAIMS

Please cancel claim 17, without prejudice or disclaimer, and rewrite claims as follows:

16 (amended). A method for the chemotherapeutic treatment of a tumor in a patient with a cytotoxic agent, which comprises the administration, during the treatment with the cytotoxic agent, of a cytotoxic potentiating [therapeutically effective] amount of an isoflavonoid of formula:



in which

- R₁, R₂, R₃, and R₄ are independently of each other, H, OH, a C₁-C₄ alkoxy group, or an -OCOR₇ group, R₇ being a C₁-C₄ alkyl group, at least one of the substituents R₁, R₂, R₃, and R₄ being other than H and it being possible for R₂ and R₃ to form together a methylenedioxy group;

- R₅ is H, OH, a C₁-C₄ alkoxy group, an O-glycosyl group, or a cyclohexyl group;

R₆ is a cyclohexyl group, a phenyl group, or a phenyl group substituted 1 to 3 times with H, OH, or a C₁-C₄ alkoxy group;

- and denotes either a double bond, or a single bond.